

## **REMARKS**

In an Office Action mailed January 24, 2006, claims 1-3, 5, 6, 8, 10, 13, 15, 19, 20, 25, 27 and 29 were rejected under 35 U.S.C. §102(e) as being anticipated by Chaddha et al. (U.S. Patent No. 6,151,632; hereinafter “Chaddha”); claims 4, 7, 11, 12, 14, 16-18 and 32 were rejected under 35 U.S.C. §103(a) as being unpatentable over Chaddha in view of Wang et al. (U.S. Published Patent Application No. 2002/0083060; hereinafter “Wang”); and claims 21-24 and 28 were rejected under 35 U.S.C. §103(a) as being unpatentable over Chaddha in view of Wang and further in view of Katseff et al. (U.S. Patent No. 5,822,537; hereinafter “Katseff”). Additionally, claims 5, 13, and 19 were rejected under 35 U.S.C. §112, first paragraph as failing to comply with the written description requirement; a rejection to an unstated claim for lack of clarity was made under 35 U.S.C. §112, second paragraph; and claims 1-8, 10-25, 27-29 and 32 were rejected under 35 U.S.C. §101 as being directed to non-statutory subject matter. Applicant respectfully traverses and requests reconsideration.

Claims 5, 13, and 19 stand rejected under 35 U.S.C. §112, first paragraph as failing to comply with the written description requirement. In particular, it is asserted that the claimed “media indexing beacon” was not described in the specification. However, Applicant notes that FIGs. 3 and 5 both illustrate a media indexing beacon (elements 302 and 502, respectively), and further description of a media indexing beacon is provided at least in paragraphs 0025-0027, 0038 and 0039 of the instant specification as originally filed. As such, Applicant respectfully submits that adequate support for the claimed “media indexing beacon” is found in the specification as originally filed and that claims 5, 13 and 19 are in suitable condition for allowance.

A rejection to an unstated claim or claims for lack of clarity has been made under 35 U.S.C. §112, second paragraph. In particular, confusion was noted whether the phrases “a media

indexing beacon” and “the beacon” referred to the same or different elements. A search of the claims has revealed only one instance of the phrase “the beacon” (noting, of course, several unrelated occurrences of the phrase “the beacon signal”) occurring in claim 19. Claim 19 has been amended above to provide correct antecedent basis. Thus, Applicant respectfully submits that claim 19, as presently amended, is in suitable condition for allowance.

Claims 1-8, 10-25, 27-29 and 32 stand rejected under 35 U.S.C. §101 as being directed to non-statutory subject matter. It is alleged that these claims (encompassing all of the presently pending claims) recite “only abstract idea[s] and non-functional descriptive material.” More particularly, it is alleged that these claims recite “steps [that] can be performed in the mind of the user or by use of a pencil and paper” and that these claims recite steps that “only constitute an idea of how to transmit[] and receiv[e] media files.”

As an initial matter, Applicant notes that claims 19, 25, 27 and 29 and their respective dependent claims, are directed to systems, apparatuses and computer-readable media that clearly fall within the classes of machines or manufactures set forth as statutory subject matter under 35 U.S.C. §101. Furthermore, each of these claims and their respective dependent claims, as set forth in M.P.E.P. §2106(IV)(B)(2)(a), “defines a useful machine or manufacture by identifying the physical structure of the machine or manufacture” and therefore define statutory products. In any event, these claims clearly recite more than mere “steps [that] can be performed in the mind of the user or by use of a pencil and paper.” For example: claim 19 recites a system comprising a “media indexing beacon” and a “media capture device”; claim 25 recites a “means for storing index information”, “means for transmitting a beacon signal” and a “media capture device”; claim 27 recites “means for capturing a subject in a media file”, “means for receiving index information” and “means for associating the index information with the media file”; and claim

29 recites “a computer readable medium” comprising “a media file” and “index information.” For these reasons, claims 19, 25, 27 and 29 and their respective dependent claims are seen to recite substantially more than abstract ideas and non-functional descriptive material and therefore constitute statutory subject matter.

Regarding claims 1, 8 and 13 and their respective dependent claims, Applicant notes that each of these claims is directed to a statutory process. Furthermore, Applicants respectfully submit that basis set forth for rejecting these claims as non-statutory, i.e., that they allegedly recite steps that “can be performed in the mind of the user or by use of a pencil and paper”, is not a proper basis for rejecting these claims as set forth in the “Interim Guidelines For Examination of Patent Applications For Patent Subject Matter Eligibility” (1300 O.G. 142, November 22, 2005) (hereinafter “Interim Guidelines”) As noted in Annex III (entitled “Improper Tests For Subject Matter Eligibility”), section (c)(i) of the Interim Guidelines:

“If a claimed process is performed by a machine, it is immaterial whether some or all of the steps could be carried out by the human mind. . . . USPTO personnel should no longer rely on the mental step test to determine whether a claimed invention is directed to statutory subject matter.”

Furthermore, as noted in section (c)(ii) of Annex III:

“It is immaterial whether the process may be performed by some or all steps that are carried out by a human. Claims are not directed to non-statutory processes merely because some or all the steps therein can also be carried out in or with the aid of a human or because it may be necessary for one performing the processes to do some or all of the process steps. The inclusion in a patent of a process that may be performed by a person is not fatal to patentability. . . . Therefore, USPTO personnel should no longer rely on the human step test to determine whether a claimed invention is directed to statutory subject matter.”

In this light, Applicant respectfully submits that the rejection of claims 1, 8 and 13 and their respective dependent claims under 35 U.S.C. §101 because these claims allegedly recite

steps that “can be performed in the mind of the user or by use of a pencil and paper” is not proper under the Interim Guidelines.

Furthermore, Applicant respectfully submits that the presently claimed subject matter constitutes substantially more than abstract ideas and non-functional descriptive material or mere ideas regarding the transmission/reception of media files. As noted in the instant specification, there are limited means of deriving index information for media. (paragraphs [0003] – [0006]) In response to this shortcoming, the present invention describes methods and devices that allow a subject of a media file to enable indexing by providing index information to a capture device, preferably through a specific device in form of a “media indexing beacon”. The focus of the present invention is not on transmitting/receiving media files, but rather on how to index media. (instant specification, paragraph [0008]) Furthermore, that the instant claims specifically recite index information being transmitted and/or received does not alter the fact that the instant claims are directed to achieving a useful, concrete and tangible result—indexing media files.

Indeed, the useful, concrete and tangible nature of the presently claimed subject matter is evident when one considers that a person could not, in his/her mind, update the index of an image on the media itself. The presently claimed subject matter does not compete with mental processing, but instead augments and complements it and, in the process, overcomes the laborious (often ineffectual) manual or automated processes of the prior art for indexing media.

Because claims 1, 8 and 13 and their respective dependent claims all recite useful, concrete and tangible results, Applicants respectfully submit that these claims constitute permissible subject matter and are therefore in suitable condition for allowance.

Claims 1-3, 5, 6, 8, 10, 13, 15, 19, 20, 25, 27 and 29 stand rejected under 35 U.S.C. §102(e) as being anticipated by Chaddha. Briefly, Chaddha teaches a system in which

multimedia information (e.g., video/audio) can be distributed via a network. Among other things, Chaddha teaches a source 202, 302, 402 “for capturing real-time video” (col. 5, line 46). The video data is thereafter provided to an encoding server 204, 304, 404 “that encodes the real-time video into a number of different bandwidth points, and associated indexes”. (col. 5, lines 46-49) Note that the system taught by Chaddha positions the “encoding server” downstream from the video source and, as a practical matter, could be distally located relative to the video source. Further note that Chaddha fails to disclose anything that teaches or even suggests that the encoding server, much less the “index information” provided by the encoding server, is in any way related to the subject captured by the video source. In summary, Chaddha generally teaches how to deliver multimedia along with indices. In contrast, the present invention addresses, in part, where the indexing information comes from. Chaddha and the present invention are complementary, not overlapping.

Instant claim 1, recites capturing a subject on a media file (akin to Chaddha’s real-time video) using a media capture device (akin to Chaddha’s video source) and receiving index information from an external source *related to the subject*. In contrast, the cited source of index information taught by Chaddha, i.e., the “encoding server” is seen to be *wholly unrelated to the subject* captured in the media file. Indeed the “index information” taught by Chaddha and provided by his “encoding server” has nothing to do with the subject captured on the media file, but instead imparts information that allows a subsequent user of the media file to navigate through the media file regardless of the subject. (col. 3, lines 24-26) To the extent that Chaddha fails to teach receiving index information from an external source related to the subject, Applicant respectfully submit that Chaddha fails to anticipate claim 1, which claim is therefore in suitable condition for allowance.

With regard to claims 2 and 3, which depends from claim 1, these claim are believed to be allowable on their merits and at least due to their dependency on independent claim 1.

With regard to claim 5, it is asserted that Chaddha teaches the claimed limitation of transmitting index information, prior to being associated with a media file, from a media indexing beacon. However, inspection of the cited portion of Chaddha (col. 8, lines 22-33), even assuming that Chaddha’s “LiveStation 404” is equivalent to the claimed media indexing beacon, reveals that the transmitted video files contain their associated indexes. Stated another way, the index information of Chaddha is transmitted by his “media indexing beacon” along with the media file it is associated with, in contrast to the claimed limitation of “prior to being associated with the media file.” Furthermore, Applicant disputes any assertion that Chaddha’s “LiveStation 404” (or his encoding servers 204, 304) is somehow equivalent to the claimed media indexing beacon. In particular, Chaddha’s “LiveStation 404” (and encoding servers 204, 304) does not transmit index information for later associating with media files; quite the opposite, these devices perform the actual association of Chaddha’s index information with corresponding media files. For these reasons, and further given its dependency from claim 1, Applicant respectfully submits that Chaddha fails to anticipate claim 5, which claim is therefore in suitable condition for allowance.

With regard to claim 6, it is asserted that Chaddha discloses the claimed limitation of receiving index information in response to an index information request. However, inspection of the cited portion of Chaddha (col. 8, lines 22-33) reveals that there is no mention whatsoever of a request for index information. Indeed, as shown in col. 7, lines 18-22, Chaddha specifically teaches away from “clients” having to request data and instead teaches “pushing” data as necessary. For this reason, and further given its dependency from claim 1, Applicant

respectfully submits that Chaddha fails to anticipate claim 6, which claim is therefore in suitable condition for allowance.

With regard to claim 8, Applicant disputes the assertion that Chaddha teaches any of the recited limitations. First, as noted above, to the extent that Chaddha teaches index information, it is not at all related to the subject being captured in a media file, as noted above with regard to claim 1. Thus, Chaddha fails to teach “storing index information *relating to a subject*”, as presently claimed. (emphasis added) Second, Chaddha is silent with regard to “index information requests”, as presently claimed, and in fact teaches a diametrically opposed technique as described above with regard to claim 6. Third, unlike the instant claim, Chaddha fails to teach transmitting index information to a media capture device, i.e., Chaddha’s “source”. On this last point, Chaddha’s source fails to receive anything from the other elements of the system; his aptly named source indeed serves no other purpose than to act as a source of video data. For these reasons, Applicant respectfully submits that Chaddha fails to anticipate claim 8, which claim is therefore in suitable condition for allowance.

With regard to claim 10, as noted above with regard to claim 8, Chaddha fails to disclose a media capture device that receives index information, much less one that associates the index information with a media file. For this reason, and further given its dependency from claim 8, Applicant respectfully submits that Chaddha fails to anticipate claim 10, which claim is therefore in suitable condition for allowance.

With regard to claim 13, the arguments presented above with regard to at least claims 1 and 5 apply equally to this claim. For these reasons, Applicant respectfully submits that Chaddha fails to anticipate claim 13, which claim is therefore in suitable condition for allowance.

With regard to claim 15, which depends from claim 13, this claim is believed to be allowable on its merits and at least due to its dependency on independent claim 13.

With regard to claim 19, it is alleged that Chaddha discloses a media indexing beacon and media capture device as claimed. As an initial matter, Applicant notes that no citation has been provided to any teachings in Chaddha reciting the claimed media indexing beacon. This is not surprising because Chaddha fails to disclose anything that “generates a beacon signal containing index information relating to a subject.” As noted previously, the index information provided by Chaddha, such as it is, is totally unrelated to the subject captured in the media file. Further still, again, as noted above, Chaddha fails to disclose any kind of media capture device that receives the index information, much less one that associates the index information with the media file. For these reasons, Applicant respectfully submits that Chaddha fails to anticipate claim 19, which claim is therefore in suitable condition for allowance.

With regard to claim 20, which depends from claim 19, this claim is believed to be allowable on its merits and at least due to its dependency on independent claim 19.

With regard to claim 25, the arguments presented above with regard to at least claims 1 and 8 apply equally to this claim. For these reasons, Applicant respectfully submits that Chaddha fails to anticipate claim 25, which claim is therefore in suitable condition for allowance.

With regard to claim 27, the arguments presented above with regard to at least claim 1 apply equally to this claim. For these reasons, Applicant respectfully submits that Chaddha fails to anticipate claim 27, which claim is therefore in suitable condition for allowance.

With regard to claim 29, the arguments presented above with regard to at least claims 1 and 8 apply equally to this claim. For these reasons, Applicant respectfully submits that Chaddha fails to anticipate claim 29, which claim is therefore in suitable condition for allowance.

Claims 4, 7, 11, 12, 14, 16-18 and 32 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Chaddha in view of Wang. Applicant notes that claims 4, 7, 11, 12, 14, 16-18 and 32 are dependent upon independent claim 1 (claims 4 and 7), independent claim 8 (claims 11 and 12), independent claim 13 (claims 14 and 16-18) and independent claim 27 (claim 32). Chaddha, as described above, fails to teach each and every limitation of independent claims 1, 8, 13 and 27, which failure is not remedied by the additional teachings of Wang. Because claims 4, 7, 11, 12, 14, 16-18 and 32 incorporate the limitations of the independent claims from which they depend, Applicant submits that the combination of Chaddha in view of Wang fails to establish a prima facie case for obviousness of claims 4, 7, 11, 12, 14, 16-18 and 32. Therefore, Applicant respectfully submits that claims 4, 7, 11, 12, 14, 16-18 and 32 are in suitable condition for allowance.

Claims 21-24 and 28 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Chaddha in view of Wang and further in view of Katseff. Applicant notes that claims 21-24 and 28 are dependent upon independent claim 19 (claims 21-24) and independent claim 27 (claim 28). Chaddha, as described above, fails to teach each and every limitation of independent claims 19 and 27, which failure is not remedied by the additional teachings of Wang and Katseff. Because claims 21-24 and 28 incorporate the limitations of the independent claims from which they depend, Applicant submits that the combination of Chaddha in view of Wang and further in view of Katseff fails to establish a prima facie case for obviousness of claims 21-24 and 28. Therefore, Applicant respectfully submits that claims 21-24 and 28 are in suitable condition for allowance.

Applicant respectfully submits that the claims are in condition for allowance and respectfully requests that a timely Notice of Allowance be issued in this case. The Examiner is

invited to contact the below listed attorney if the Examiner believes that a telephone conference will advance the prosecution of this application.

Date:

3/24/06

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